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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			CHANG, SHIRLEY	
			ART UNIT	PAPER NUMBER
			2614	
DATE MAILED: 01/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/898,014	MAMEDA, KENJI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shirley Chang	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed on 8/31/05 have been fully considered but they are not persuasive with respect to arguments pertaining to the amended limitations and the applied art of record not teaching the amended limitations. The examiner respectfully disagrees and refers to the grounds of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1, 8, 9, 12 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Portuesi (US 5,987,509).**

As to claim 1, Portuesi discloses:

A separation unit separating, from a broadcast wave, video data, video associated data, and button data linked with the video associated data (fig. 5, element 68; [9, 35-58]; [6, 30-42]);

a display unit displaying a video based on the video data, and also displaying a button associated with the button data as the video changes in a course of a program, the display unit further displaying the linked video associated data when the button is selected by a user (fig. 4, element 28; hotspot 40 (claimed button); Display Window 28

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unit displays Caption 34 corresponding to selecting hotspot 40 [6, 34-37]; link 32 is display only for a specific period of time [6, 3-30]).

As to claim 8, Portuesi discloses:

A separation unit separating video data and video associated data from broadcast wave (fig. 5, element 68; [9, 35-58]; [6, 30-42]);

A display unit displaying the video separated by said separation unit (display window 28, Figure 4; hotspot 40, Figure 4),

A communication unit receiving a command from an external apparatus requesting for the video associated data, and transmitting the video associated data to the external apparatus to be displayed on the external apparatus (fig. 5; element 52 transmits information that element 56 requests. Element 56 then displays the information on element 70).

As to claim 9, Portuesi discloses:

A still picture production unit producing still picture from the video data, wherein said separation unit further separates button data linked with video associated data from the broadcast wave (fig. 5, element 68; [9, 35-58]; [6, 30-42]; a typical broadcast displays 30 frames per second, which equates to displaying 30 "still pictures" per second [4, 37-39]);

and said communication unit transmits the button data, and the still picture produced by said still picture production unit to the external apparatus to be displayed on the external apparatus (fig. 5; element 52 transmits information that element 56 requests. Element 56 then displays the information on element 70).

As to claim 12, Portuesi discloses:

A communication unit receiving data and an image from an external apparatus, the external apparatus having a separation unit separating, from a broadcast wave, video as a source of the image, video associated data, and button data linked with the video associated data (fig. 5, element 68; [9, 35-58]; [6, 30-42]);

A display unit displaying the image received by said communication unit and displaying a button on said image based on the button data; a select unit selecting a button displayed by said display unit, said display unit displaying the video associated data corresponding to the button selected by said select unit (fig. 4, element 28; hotspot 40 (claimed button); Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 [6, 34-37]; link 32 is display only for a specific period of time [6, 3-30]; hotspot selection (button selection) [6, 34-36]).

As to claim 18, Portuesi discloses:

a separation unit separating, from a broadcast wave, video, video associated data, and button data linked with the video associated data the button data including button coordinates and expiration data associated with characters or objects entering in the video; and (fig. 5, element 68; [9, 35-58]; [6, 30-42]; figs. 3, 4; link 32 is played only for a specific period of time),

a display unit displaying the video, and also displaying a button placed at the coordinates associated with the characters or the objects entering in the video for a period of time determined by the button expiration data, the display unit further displaying the linked video associated data when the button is selected by a user (fig.

4, element 28; hotspot 40 (claimed button); Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 [6, 34-37]; link 32 is display only for a specific period of time [6, 3-30]; fig. 5, element 68; [9, 35-58]; [6, 30-42]; figs. 3, 4).

As to claim 19, Portuesi discloses:

button data further includes an area associated with the characters or the objects and said display unit further displays the area associated with the characters or the objects entering in the video as the button (fig. 4, element 28; hotspot 40; Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 [6, 34-37]; link 32 is display only for a specific period of time [6, 3-30]; fig. 5, element 68; [9, 35-58]; [6, 30-42]; figs. 3, 4),

### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claim(s) 2 and 17 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable over Portuesi (5987509).**

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As to claim 2,

Portuesi discloses:

An infrared receive unit receiving a command from an external source through infrared radiation (there inherently exists a cursor move unit, since there is a pointer 38 (cursor) as shown in Figure 4)

Button retrieval unit retrieving a button located at a position of said cursor (there inherently exists a claimed button retrieval unit since there is a hotspot 40 (button), Figure 4)

Wherein said display unit displays video associated data corresponding to the button retrieved by said button retrieval unit (Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 [6, 34-37]).

Although the Portuesi reference fails to disclose an infrared receive unit, the examiner gives Official Notice that it is notoriously well known in the art to utilize an infrared receiving pointing device such as the TV receiver remote control, which thereby gives existence to an infrared receive unit. Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference to use an infrared device, which effectively makes necessary the existence of an infrared receive unit.

As to claim 17,

A broadcast apparatus superposing video and data on a broadcast wave for transmission ; a broadcast receiver apparatus receiving the broadcast wave transmitted from said broadcast apparatus (figs. 1, 4, 5; [9, 35-58]);

Said broadcast receiver apparatus including,

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A separation unit separating video data and button data linked with the video associated data from data included in the broadcast wave transmitted from said broadcast apparatus (fig. 5, element 68; [9, 35-58]; [6, 30-42]);

A display unit displaying the video based on the video data, and displaying a button associated with the button data (display window 28, Figure 4; hotspot 40 (claimed button), Figure 4),

A select unit selecting a button displayed by said display unit in response to designation from said remote controller (inherent in a system that allows hotspot selection (button selection) [6, 34-36]),

wherein said display unit displays the video associated data corresponding to a button selected by a user (Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 [6, 34-37]).

Although the Portuesi reference does not specifically disclose a remote control, the examiner gives Official Notice that it is notoriously well known in the art to utilize an infrared receiving pointing device such as the TV receiver remote control. Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference to use an infrared device.

**3. Claims 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi (US 5,987,509) in view of Narayan et al. (US 6,859,937).**

As to claim 10,

Portuesi discloses:

the claimed separation unit and display unit are met as discussed in claim 8.



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A first communication unit receiving an externally applied command from an external apparatus provided separately from the broadcast receiver apparatus and operated by a user to transmit the button data ('user input device...which can comprise a keyboard and a mouse or other pointing device' [4, 40-43] ; URL Window 30, Figure 3)

Although Portuesi does not specifically disclose receiving an electronic mail from the external apparatus, Narayan teaches an email function and button as shown in fig. 4.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Portuesi with White so as to send and receive email in the URL window 28 after user selects a hotspot.

A second communication unit transmitting the electronic mail received by said first communication unit (since email can be accessed, there is effectively exists the communication unit).

As to claim 11,

Portuesi discloses:

A still picture production unit producing a still picture from the video separated by said separation unit (still pictures as discussed in claim 8 and Movie File with Embedded URLs 60),

Wherein said first communication unit transmits the button data included in the data separated by said separation unit and the still picture produced by said still picture production unit to the external apparatus (The communication unit as explained in claimed 10 inherently transmits the hotspot 40 information (button information) and still picture as previously discussed to the display window 28).

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As to claim 13,

the claimed communication unit is met by that described in claim 12 and claim 10 for “receiving data and an image” and “transmitting electronic mail” respectively.

the claimed display unit and select unit are met by that discussed in claim 12,

the claimed mail production unit is met by that discussed in claim 10 since the button data retrieved by the button retrieval unit in claim 10 will have the same effect as the data that is retrieved by the select unit.

**4. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi (US 5,987,509) in view of Narayan (US 6,859,937), in further view of Shaw et al. (US 6,516,341).**

As to claim 14,

Portuesi does not specifically disclose using a template to produce email. Shaw discloses clicking on a button, which opens a screen and creates a template for an email message [18, 1-5]. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Portuesi in view of Narayan with Shaw so as to ‘enable the user to easily compose an email message’ [6, 14-25].

As to claim 15,

Portuesi does not specifically disclose using a button including a mail address. Shaw discloses email produced with mail address include in button data [18, 1-5].

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Portuesi in view of Narayan with Shaw so as to produce email to “enable the user to easily compose an email message” [6, 20-25].

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As to claim 16,

Portuesi does not specifically disclose the user information managing unit. Shaw et al. discloses that "existing email networks determine at the server side and while the user is online who the user is and that user's mail server" [3, 1-3]; a "member profile stored at the server system 104 on the database management system 106 [12, 46-60].

Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference to use an information managing unit "to aid in selecting or targeting advertisements and email messages...to desired users" [46-60].

**5. Claim(s) 3-5 and 7 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable over Portuesi (5790935) in view of White (20060010478).**

As to claim 3,

Portuesi discloses:

A separation unit separating, from a broadcast wave, video, video associated data, and button data linked with the video associated data (URL Decode Unit 68 [9, 38-42];

Figure 5)

A display unit displaying the video separated by said separation unit, and displaying a button on said video based the button data (display window 28, Figure 4; hotspot 40 (claimed button), Figure 4)

Portuesi does not specifically disclose the button data including a mail address and button information for mail body provided by a broadcaster, and the claimed mail production and transmission unit. White discloses the button data including a mail address and button information for mail body provided by a broadcaster and mail

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production and transmission unit (the user can e-mail a question and just hit Return [0070]). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Portuesi with White so as to create an email by hitting Return, instead of having to compose an email entirely from scratch [0070].

As to claim 4,

the infrared receive unit, cursor move unit, and button retrieval unit are met as discussed in claim 2.

The claimed mail production unit is met by that discussed in claim 10 since the data that is obtained corresponding to the one the user selected will effectively have the same data that the button retrieval unit receives from the button the user selects.

As to claim 5,

White discloses:

Said mail production unit produces said electronic mail using a template included in button data corresponding to the button retrieved by said button retrieval unit (the user can e-mail a question and just hit Return [0070]).

As to claim 7,

White discloses:

Said mail production unit produces said electronic mail based on user information under control of said user information managing unit (the user can e-mail a question and just hit Return [0070]).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC



**HAI TRAN  
PRIMARY EXAMINER**